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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/964,034 | 09/26/2001 | John A. M. Cameron | WEAT/0151 | 9883 |

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HALFORD, BRIAN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3672 | |

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 09/964,034 | Applicant(s) CAMERON, JOHN A. M. |
| | Examiner Brian D Halford | Art Unit 3672 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 September 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-13 and 15-30 is/are rejected.

7) Claim(s) 14 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 26 September 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the geometry of Claim 4 must be shown or the feature(s) canceled from the claim(s). Specifically, a recess wherein a first arcuate wall possessing a first and second end in addition to a second wall also possessing a first and second end wherein the first and second ends of the respective walls connect is not shown. It is noted that a recess wherein the first and second walls are connected by end walls are shown. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the crescent-shaped encapsulation of Claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 6 contains the phrase, "The recess of claim 6"; consequently, the paradoxical statement renders Claim 6 as indefinite. Claim 5 is considered indefinite since it depends from Claim 6.

5. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 25 contains the unclear phrase, "generally shaped"; consequently, a range of general shapes has not been delineated.

6. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claim 26 contains the phrase, "generally complies"; consequently, the unqualified phrase fails to set a range of compliance and is indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-3, 7, 19, 22-23, 27 and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Castano-Mears *et al.* Castano-Mears *et al.* disclose a downhole expandable well screen that expands to substantially contact the wall of the wellbore. Furthermore, as stated in lines 19-25 of Column 1, the expandable well screen finds employment with productive, relatively unconsolidated downhole formations. As shown in Figures 15-18 and discussed in lines 8-40 of Column 11, the expandable well screen (166) contains tubular ribs or recesses (172) that are utilized to convey myriad types of instrumentation lines. Lines 36-40 of the aforementioned column clearly state that any type of line may be inserted through the hollow ribs or recesses (172). Figure 18 lucidly depicts the hollow rib or recess (172) containing a hydraulic or chemical injection line (176), an electrical line (178) and a fiber optic line (180).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castano-Mears *et al.* in view of Applicant's specification. Castano-Mears *et al.* provide a circular recess as previously discussed. Castano-Mears *et al.* fail to provide, however, a recess possessing a first arcuate wall having a first and second end in addition to a second wall also possessing a first and second end wherein the first and second ends of the respective walls connect. Applicant has failed to demonstrate the criticality of the recess geometry; moreover, Applicant suggests several geometries for the recess. Therefore it would have been obvious to one possessing ordinary skill in the art, at the time the invention was made, to modify the rib or recess geometry of Castano-Mears *et al.* to possess a first arcuate wall having a first and second end in addition to a second wall also possessing a first and second end wherein the first and second ends of the respective walls connect. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

11. Claims 8, 10-13, 15-18, 20-21, 24-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castano-Mears *et al.* in view of Ramos *et al.* as applied to Claim 9 above. Castano-Mears *et al.* disclose a downhole expandable well screen as discussed above. However, Castano-Mears *et al.* fail to disclose a crescent-shaped encapsulation for positioning within the recess for the purpose of line conveying. Ramos *et al.* disclose a cable for connection to permanent downhole sensors. As mentioned in lines 47-53 of Column 1 a resilient sheath surrounds the cable. The deformable sheath may be fabricated from resilient materials, such as thermoset plastic or nitrile rubber, to circumvent cable breakage. Though not specifically disclosed, it is

noted that metal is a resilient material and is capable of deformation. Ramos *et al.* disclose in lines 48-55 of Column 5 a crescent-shaped cable housing for connecting cable to downhole sensors. Depicted lucidly in Figure 4, the cable (96) and metal sheath are enveloped and supplemented by moulded wings (100, 102); moreover, the resultant crescent geometry of the wings (100, 102) and metal sheath or tubular is substantially identical to that claimed by Applicant. It is noted that the wings (100, 102) and metal sheath or tubular provide an encapsulation for the cable (96). However, it is noted by the Examiner that Castano-Mears *et al.* disclose in lines 41-45 that the ribs or recesses (172) may collapse under excessive expansion force. Therefore, it would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to insert the crescent-shaped encapsulation of Ramos *et al.* into a mating recess of Castano-Mears *et al.* to shoulder any excessive force thereby promoting the integrity of the conveyed lines or sensors.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 10-13, 15-16, 18, 20 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/964160. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure and geometry of the encapsulation in the instant invention is clearly and lucidly delineated in Claims 1, 7, 9 and 12 of copending Application No. 09/964160; moreover, both applications contain claims drawn to an expandable sand screen and an encapsulation that serves as a housing for lines or sensors.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

14. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to Evans *et al.* disclose an encapsulated control line for employment in wellbores. The patent discloses metal tubulars and filler material,

which avoids cable twisting or pinching. The patent application publication to Echols et al. disclose an expandable well screen having a line extending therethrough. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Halford whose telephone number is (703) 306-0556. The examiner can normally be reached on M-F 8:30-6:00; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1020.

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

BDH
January 23, 2003

oneuder
William Neuder
Primary Examiner